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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,379	10/27/2000	Teresa Martineau	MS150499.1	6348

27195 7590 05/10/2004

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,379

Applicant(s)

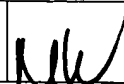
MARTINEAU ET AL.

Examiner

Mark Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to Office Action mailed 8/27/2003, which was received by the office 12/12/2003. Acknowledgement is made to the amendment to claims 1-35 and 40, leaving claims 1-40 as pending in the application. The applicant's amendments and arguments have been carefully considered, but were found not to be persuasive; therefore the previous rejection is restated below:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-40 rejected under 35 U.S.C. 102(b) as being anticipated by Robertson (6,609,106).

In regards to claims 1-40, Robertson teaches all the limitation of the instant claims. For instance, Robertson teaches an online Gift Registry Service provides registration of information for a gift registrant and allows access to the registry by potential gift giver users. In addition, users can tag items of interest at participating

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Service Provider (SP) sites and the SP sites will register these items with the Gift Registry Service on the user's behalf. It further provides a streamlined checkout process for purchasing these gift items with the registered SP sites (e.g. World Wide Web sites) over a distributed public network. Users and Service Providers (SP) initially register with the Gift Registry Service and are provided additional functionality. For users, a reminder service is provided to notify individuals automatically upon the trigger of certain events, such as important dates or product sales from online merchants. In addition, there are various occasion planning services available such as distribution lists, discussion groups, and other related resources for multiple events including weddings, baby showers, etc. These other resources include sending out announcements, reserving halls, and contracting services of related businesses for the occasion. A distinct advantage of this system is that users can perform all the planning for the event online in the comfort of their home or office. Service Providers on the other hand, can register system notification messages to be triggered on pre-determined events. In addition, Service Providers can obtain marketing information to tailor their products and services.

Response to Arguments

In regards to claims 1-40 applicant's arguments filed 12/12/2003 have been fully considered but they are not persuasive.

In regards to claims 1,26, and 35 applicant argues that Robertson does not teach *an interface component that utilizes item references stored within an item database to extract data and create an item list based on the extracted data*. The examiner disagrees and directs the applicant's attention to col 10, lines 35-55, where the purchaser accesses a wish list database to create an item list based on filtered items in a registrant's wish list which is stored in a database (col 12, lines 35-40).

In regards to claims 1,26, and 35 applicant argues that Robertson does not teach *retrieving and utilizing references to items to extract data from a database wherein the data is employed to generate an item list that is returned to the requestor*. The examiner disagrees and directs the applicants attention to at least col 23, line 33- col24, line 76. see particularly Alternate gift button where information from the wish list database is used to determine what alternative gifts may satisfy the purchaser's and the gift recipient's needs.

In regards to claims 1,26, and 35 applicant argues that Robertson does not teach *storing references to the items in an item list database*. The examiner disagrees and directs the applicant's attention to at least col 21, lines 59-67, where a merchant lists themselves as reseller of the item in the database thus referencing themselves to the items in the database (see also, col 14, lines 40-50).

In regards to claim 12 applicant argues that Robertson does not teach *degrading items on a list when the items are removed from storage within a database*.

"As records are removed from the supporting databases, the interface allows for graceful degradation of the display, such that something is always displayed to the user".

"Fig. 9 illustrates one particular methodology of degradation of items in the item list as records are removed from at least one of the databases in accordance with one aspect of the present invention."

"If data previously available has been removed from the databases, the interface component performs a degradation methodology and returns the best data available. If an item has been removed from the merchant, manufacturer, offer, product and category databases that is in the user's item list (e.g., item list database 26), the interface component is operable to proceed through a series of steps to degrade the data gracefully, such that the best available information within the databases is always provided to the user. For example, if an offer is not available any longer that is in a user's item list, the interface component may then provide the user with a link to the merchant's site or other items that may be similar to the listed item, such as items in a related product class or items in a related product category."

The examiner notes that as best understood by the applicant's specification, referring to that which was extracted from the specification noted above; it is understood that applicant's reference to degrading is synonymous to presenting some alternative to a buyer when a merchant removes reference to their ability to supply an item. Robertson clearly shows "joined items" products that are sold by a plurality of resellers (merchants that provide the same product), therefore should one reseller remove themselves as a reseller the database would inherent degrade the system by offering another option e.g. another reseller.

In regards to claim 12 applicant argues that Robertson does not teach *degrading an item in response to the item becoming no longer available*. In response to applicant's argument that the references fail to show certain feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., teach *degrading an item in response to the item becoming no longer available*) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to claim 14 applicant argues that Robertson does not teach *an item list with structured and unstructured item information*. The examiner disagrees and directs the applicant's attention to their own disclosure page 13, lines 1-10, which state that examples of structured data are Price, URL, merchant ID ect, and unstructured data is texts description, merchant name ect. Robertson clearly shows this data arrangement in FIG 41.

In regards to claim 20 applicant argues that Robertson does not teach *linking an item list infrastructure to a remote site*. The examiner disagrees and directs the applicant's attention to at least FIGs 10A and B, where there is a clear link between the SP site and the gift registry; see also FIG 34 and multiple resellers site locations listed linking registered items with remote sites. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the

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location of the database at any location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

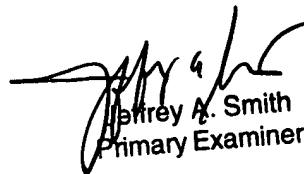
(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner



Jeffrey A. Smith
Primary Examiner